App. No. 09/895,471
Amendment Dated: October 12, 2005
Reply to Office Action of August 18, 2005

REMARKS/ARGUMENTS

I. Current State of Prosecution

In the Office Action dated April 5, 2005, the Examiner stated that "claims 18-19 and 21-24 would be allowable if rewritten to overcome the rejections under 35 U.S.C. §112, 2nd paragraph, and to include all of the limitations of the base claim and any intervening claims." New claims 33-35 were added in the Amendment dated April 25, 2005. In that Amendment claims 19, 22 and 23 were amended to depend from independent claims 33 and 34, respectively.

The current Office Action rejects claims 19, 22-23 and 33-34 under new grounds. Claims 19, 22-23 and 33-34 have been amended as set forth above to clarify the invention. Applicants assert that the claims are in condition for allowance in view of the above amendments and the arguments set forth herein. Applicants respectfully request reconsideration and a Notice of Allowance.

II. Rejection of Claims 33 and 19 Under 35 U.S.C. §101

Claims 33 and 19 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Applicants believe that the rejection is moot in view of the amendments to the claims above. In that claims 19 and 33 were not further rejected, applicants believe that those claims include allowable subject matter.

In support for the above language, applicants note *In re Warmerdam* (hereinafter "*Warmerdam*"). 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994). *Warmerdam* stands for the proposition that abstract ideas or laws of nature, which constitute descriptive material, are non-

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statutory. *See Warmerdam*, 31 USPQ2d at 1759. However, when functional descriptive material

is recorded on some computer-readable medium *it becomes structurally and functionally*

interrelated to the medium and will be statutory in most cases *since use of technology permits*

the function of the descriptive material to be realized. See In re Lowry, 32 F.3d 1579, 1583-84,

32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (stating that a claim to a data structure stored on a

computer-readable medium that increases computer efficiency is statutory), and *Warmerdam*, 33

F.3d at 1360-61, 31 USPQ2d at 1759 (stating that a claim to a computer having a specific data

structure stored in memory is a statutory product-by-process claim). (Emphasis added).

III.   Rejection of Claims 22-23 and 34-35 Under 35 U.S.C. §103(a)

Claims 22-23 and 34-35 are rejected under 35 U.S.C. §103(a) as being unpatentable over

U.S. Patent No. 6,775,559 issued to Weghorst et al. (hereinafter "Weghorst") in view of U.S.

Publication No. 2001/0049263 published to Zhang (hereinafter "Zhang"). Applicants assert that

the references may not be modified in the manner propounded. Even though applicants

respectfully disagree with the combination of references, the claims have been amended as set

forth above to further clarify the invention. Along with other elements in the claim, independent

claim 34 includes the following combination of elements that are not taught or otherwise

suggested by the cited references:

> "receiving a configuration message *having at least one declaration statement that declares a payload having a new state of settings stored on the mobile device*"

> "returning a response document to an initiator of the configuration message, *the response document including the at least one declaration statement associated with the configuration message*"

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Applicants can find no teaching or suggestion of the above combination of elements in the cited references. Moreover, the amendment of claim 34 does not include new matter. The below citation is not meant to limit the claims in any manner. The below citation is but one example of support for the above amendment that is recited in the specification. The specification recites as follows:

> "In accordance with this implementation of the invention, the configuration message 122 is based on a declaratory syntax rather than an instructional syntax. In other words, rather than putting forth statements which request that an action be performed (e.g., "make setting_value = X"), the declaratory syntax allows changes to be set forth as declarations of state (e.g., "setting_value = X"). This distinction provides some unforeseen advantages over an instructional syntax, namely that the configuration message 122 essentially describes the state of the affected settings after the provisioning transaction, and may therefore be used as a response document as well. For instance, if the provisioning transaction completes without error, the configuration message may essentially be returned unchanged to indicate the success, with the exception of query statements being modified to reflect the value of the queried setting. This feature greatly simplifies the maintenance of the configuration message throughout the provisioning transaction and simplifies the creation of a response document." *Specification*, at pg. 18, line 30 – pg. 19, line 11.

In view of the above, applicants believe that claim 34 is in condition for allowance. Applicants respectfully request reconsideration in light of the same. Along with other elements in the claim, independent claim 35 includes the following combination of elements that are not taught or otherwise suggested by the cited references:

> "receiving a configuration message *having at least one declaration statement that declares a payload having a new state of settings stored on the mobile device*"

Independent claim 35 includes a similar element as recited in claim 34. Applicants contend that claim 35 is allowable for at least the same reasons set forth above in support for claim 34. Regarding dependent claims 22 and 23, applicants assert that those claims include
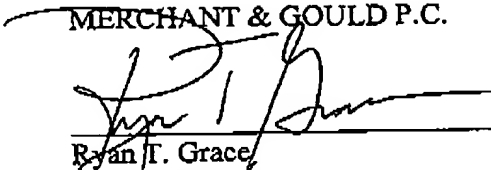
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elements that are not taught or otherwise suggested by the cited references. Moreover, claims 22

and 23 depend from claim 34. Claim 34 is allowable for the above stated reasons. Accordingly,

applicants believe that claims 22 and 23 are allowable for at least those same reasons.

In view of the foregoing amendments and remarks, all pending claims are believed to be

allowable and the application is in condition for allowance. Therefore, a Notice of Allowance is

respectfully requested. Should the Examiner have any further issues regarding this application,

the Examiner is requested to contact the undersigned attorney for the applicants at the telephone

number provided below.

Respectfully submitted,

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